

### **REMARKS**

Claim 38 has been added by the present amendment. Therefore, claims 1- 38 are pending in the present application. Claims 12-21 and 33-37 have been withdrawn from consideration. Claims 38 recites that the at least one connector comprises two connectors. Support for this amendment can be found, *inter alia*, on page 5, paragraph 20 of the specification.

The specification stands objected to for allegedly failing to provide proper antecedent basis for the claimed subject matter. Claims 1-11 and 22-32 stand rejected under 35 U.S.C. 112 for allegedly lacking enablement.

### **The Specification Provides Proper Antecedent for the Claimed Subject Matter**

According to the Examiner, the specification does not provide proper antecedent basis for a joint prosthesis having at least one connector. Applicants submit that this subject matter is disclosed in several parts of the specification. For example, on page 4, paragraph 8, the specification states that the “bioabsorbable joint prosthesis system, which can create a new, functional joint *in situ*, comprises at least one bioabsorbable spacer and at least one connector.” (*emphasis added*). On page 4, paragraph 9, the specification states, “[i]n an embodiment of the present invention, the method includes interposing at least one bioabsorbable spacer between the surface of the bones to be joined and connecting the bones with at least one connector such that at least a part of the connector contacts the bioabsorbable spacer.” (*emphasis added*). On page 5, paragraph 19, the specification states, “the biohybrid bioreplaceable joint prosthesis of the present invention may include a cylindrical, porous joint spacer and at least one connector” (*emphasis added*). Accordingly, Applicants submit that the specification provides ample antecedent basis for a joint prosthesis having at least one connector and request withdrawal of this objection.

### **The Claims Are Enabled**

Claims 1-11 and 22-32 stand rejected for lack of enablement. According to the Examiner, claims 1 and 23 recite a joint prosthesis having at least one connector but the

specification “does not describe how the present invention with one connector would enable one skilled in the art to use the invention.”

The present claims recite a joint prosthesis system comprising at least one bioabsorbable spacer and “at least one connector.” Applicants submit that the specification enables one skilled in the art to use a joint prosthesis with “at least one connector,” as recited in the present specification. First, the specification generally describes how to use at least one connector in the joint prosthesis. For example, on page 4, paragraph 9, the specification states that at least one bioabsorbable spacer is interposed between the surfaces of the bones to be joined and the bones are connected with “at least one connector such that at least a part of the connector contacts the bioabsorbable spacer.” On page 5, paragraph 19, the specification states that the “connector maintains the position of the joint spacer in the joint cavity by contacting the outer surface of the spacer.” Therefore, the specification provide sufficient disclosure of where the at least one connector is placed as well as the function of the at least connector to enable one skilled in the art to use “at least one connector” in the joint prosthesis system.

Furthermore, the specification specifically disclose the use of two connectors in the joint prosthesis system, which is encompassed by the limitation “at least one connector.” See paragraph 20 and Figure 1. As the Examiner is well aware, “as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, the enablement requirement is satisfied.” *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970). Applicants submit that the specification’s disclosure of a method of using “at least one connector” as described above, as well as the specific disclosure and drawings of using two connectors, enables one skilled in the art to use the joint prosthesis with at least one connector, as recited in the claims. Applicants submit that it is not required that the specification specifically describe the use of just one connector in order to fulfill the enablement requirement since the general use of “at least one connector” is described in the specification and the specific use of two connectors is described in the specification, which falls under the limitation of “at least one connector” of claims 1 and 23.

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Furthermore, the drawings enable one skilled in the art to make and use a joint prosthesis with one connector. Specifically, **FIG. 1** depicts the structural relationship of two connectors 4' and 4" relative to a joint spacer 3 and to two bones 1 and 2. If only a single connector is desired, it would be understood by one skilled in the art to simply removed one of connectors 4' and 4". No undo experimentation is needed to use the joint prosthesis as recited in claims 1 and 23 with only one connector. For at least these reasons, Applicants submit that claims 1 and 23 (and all claims that depend therefrom) are enabled and Applicants respectfully request withdrawal of this rejection.

### CONCLUSION


It is respectfully submitted that the present application is now in condition for allowance, which action is respectfully requested. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of the subject application.

Any fees for extension(s) of time or additional fees are required in connection with the filing of this response, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is authorized to charge any such required fees or to credit any overpayment to Kenyon & Kenyon's Deposit Account No. 11-0600.

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